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09/250,711	02/16/1999	PETER J. KIGHT	1761100-B075	2331

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EXAMINER

CAMPEN, KELLY SCAGGS

ART UNIT PAPER NUMBER

3624

DATE MAILED: 02/11/2004

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 32

Application Number: 09/250,711

Filing Date: February 16, 1999

Appellant(s): KIGHT ET AL.

\_\_\_\_\_  
Alfred Stednicki  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 8-22-03.

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**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

No amendment after final has been filed.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: Based on Applicant's arguments on pages 14-15 of the Supplemental Appeal brief, the 112 second paragraph rejection has been withdrawn.

**(7) *Grouping of Claims***

The rejection of claims 1, 4-5, 21, 25, 34-35, 39-40, 44-45, 49-50, 54, and 56 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

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**(9) Prior Art of Record**

5,220,501	Lawlor et al.	6-1193
5,265,008	Benton et al.	11-1993

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 4-5, 21, 25, 34-35, 39-40, 44-45, 49-50, 54, and 56 rejected under 35 U.S.C.

103. This rejection is set forth in prior Office Action, Paper No. 30.

**(11) Response to Argument**

In response to the 112 first paragraph rejection,

The first paragraph of 35 U.S.C. 112 provides:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. [emphasis added].

The written description requirement is separate and distinct from the enablement requirement. *In re Barker*, 559 F.2d 588, 194 USPQ 470 (CCPA 1977), *cert. denied*, 434 U.S. 1064 (1978); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1562, 19 USPQ2d 1111, 1115 (Fed. Cir. 1991) (While acknowledging that some of its cases

concerning the written description requirement and the enablement requirement are confusing, the Federal Circuit reaffirmed that under 35 U.S.C. 112, first paragraph, the written description requirement is separate and distinct from the enablement requirement and gave an example thereof.). An invention may be described without the disclosure being enabling (e.g., a chemical compound for which there is no disclosed or apparent method of making), and a disclosure could be enabling without describing the invention (e.g., a specification describing a method of making and using a paint composition made of functionally defined ingredients within broad ranges would be enabling for formulations falling within the description but would not describe any specific formulation). See *In re Armbruster*, 512 F.2d 676, 677, 185 USPQ 152, 153 (CCPA 1975) (“[A] specification which describes’ does not necessarily also enable’ one skilled in the art to make or use the claimed invention.”). Best mode is a separate and distinct requirement from the enablement requirement. *In re Newton*, 414 F.2d 1400, 163 USPQ 34 (CCPA 1969).

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To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116. >However, a showing of possession alone does not cure the lack of a written description. *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 296 F.3d 1316, 1330, 63 USPQ2d 1609, 1617 (Fed. Cir. 2002).< Much of the written description case law addresses whether the specification as originally filed supports claims not originally in the application. The issue raised in the cases is most often phrased as whether the original application provides “adequate support” for the claims at issue or whether the material added to the specification incorporates “new matter” in violation of 35 U.S.C. 132. The “written description” question similarly arises in the interference context, where the issue is whether the specification of one party to the interference can support the newly added claims corresponding to the count at issue, i.e., whether that party can “make the claim” corresponding to the interference count. See, e.g. *Martin v. Mayer*, 823 F.2d 500, 503, 3 USPQ2d 1333, 1335 (Fed. Cir. 1987). In addition, early opinions suggest the Patent and Trademark Office was unwilling to find written descriptive support when the only description was found in the claims; however, this viewpoint was rejected. See *In re Koller*, 613 F.2d 819, 204 USPQ 702 (CCPA 1980) (original claims constitute their own description); *accord In re Gardner*, 475 F.2d 1389, 177 USPQ 396 (CCPA 1973); *accord In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976). It is now well accepted that a satisfactory description may be in the claims or any other portion of the originally filed specification. These early opinions did not address the quality or specificity of particularity that was required in the description, i.e., how much description is enough.

An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was “ready for patenting” such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention. See, e.g., *Pfaff v. Wells*

*Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998);

*Eli Lilly*, 119 F.3d at 1568, 43 USPQ2d at 1406; *Amgen, Inc. v. Chugai*

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Pharmaceutical, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991)

(one must define a compound by “whatever characteristics sufficiently distinguish it”).

"Compliance with the written description requirement is essentially a fact-based inquiry

that will necessarily vary depending on the nature of the invention claimed. " Enzo

Biochem, 296 F.3d at 1324, 63 USPQ2d at 1613. An application specification may

show actual reduction to practice by describing testing of the claimed invention or, in the

case of biological materials, by specifically describing a deposit made in accordance with

37 CFR 1.801 et seq. >See Enzo Biochem, 296 F.3d at 1326, 63 USPQ2d at 1614

("reference in the specification to a deposit may also satisfy the written description

requirement with respect to a claimed material"). (see, e.g., >New Railhead Mfg. L.L.C. v.

Vermeer Mfg. Co., 298 F.3d 1290, 63 USPQ2d 1843 (Fed. Cir. 2002);< Tronzo v. Biomet, Inc.,

156 F.3d 1154, 47 USPQ2d 1829 (Fed. Cir. 1998); Fiers v. Revel, 984 F.2d 1164, 25 USPQ2d

1601 (Fed. Cir. 1993); In re Ziegler, 992 F.2d 1197, 1200, 26 USPQ2d 1600, 1603 (Fed. Cir.

1993)), or whether a specification provides support for a claim corresponding to a count in an

interference (see, e.g., Fields v. Conover, 443 F.2d 1386, 170 USPQ 276 (CCPA

1971)). Compliance with the written description requirement is a question of fact which

must be resolved on a case-by-case basis. Vas-Cath, Inc. v. Mahurkar, 935 F.2d at

1563, 19 USPQ2d at 1116 (Fed. Cir. 1991).

Pages 18-21 of the Appeal Brief are a repeat of the earlier argument.

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In response to Applicant's arguments concerning the use of Benton et al., Benton et al. is being applied only to show evidence of the ubiquitously well-known nature of ACH and ATM methods of electronic funds transfer at the time that the invention was made. Lawlor et al. is not being modified by the specific ACH debiting of Benton et al. but by the ubiquitously well-known ACH method of funds transfer as disclosed in Benton et al.

With regards to Applicant's argument that there is no reasonable expectation of success, one of ordinary skill in the art would know that ACH transfer could be used to debit the account in connection with the electronic payments. Pages 23-27 are a repeat of this argument.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



KSC

January 29, 2004

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